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Paper No. 26

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In re Application of: Yates, Jr. et al.)
Application No. 09/385,394)
Attorney Docket No. 5231.03-4000) DECISION ON PETITION INVOKING
Filed: August 30, 1999) SUPERVISORY AUTHORITY UNDER
For: COMPUTER WITH TWO) 37 CFR §1.181
EXECUTION MODES)
)

This is a decision on the petition and supplemental petition filed via facsimile on May 2, 2003 to withdraw the final rejection (Paper No. 11) mailed on October 1, 2002. The petition is being considered as a petition invoking supervisory authority under 37 CFR §1.181. As the "Supplemental Petition for Withdrawal of Finality" appears to incorporate the arguments of the "Petition for Withdrawal of Finality" along with supplemental arguments, this decision will address the content of the "Supplemental Petition."

The petition is **DENIED**.

Applicable Prosecution History

Feb 20, 2002 First Action on the Merits (FAOM) mailed. Claims 1, 2, 4-18, 21-28, 30-33, 37-59, 61-75, 77, 78, 94 rejected under 35 USC §102(b) using US Patent 5,481,684 (Richter et al., hereafter "Richter"). Claims 3, 19, 29, 76, 79-85, 87-93, 95 rejected under 35 USC §103 using Richter.

Jun 26, 2002 Applicants file response to FAOM (Paper No. 10).

Oct 01, 2002 Final rejection mailed (Paper No. 11). Claims 97-100, 102, and 103 rejected under 35 USC §112, 2d paragraph. Claims 51-59, 61-75, 77, 78, 94, 96-98, 102-111, 113-115, and 128-133 rejected under 35 USC §102 using Richter. Claims 22-33, 76, 79-85, 87-93, 95, 99-101, 112, and 116-127 rejected under 35 USC 103 using Richter. Claims 1-21, 37-50 were indicated as allowable. Claims 34-36 and 60 were objected to.

Dec 02, 2002	Applicants file two papers: an amendment and a request for withdrawal of finality of the Office action (listed as Paper No. 12).
Jan 21, 2003	Applicants file Information Disclosure Statement (IDS) with attorney statement that the filing has occurred before a final rejection (Paper No. 13).
Feb 10, 2003	Examiner mails notification of non-entry of after-final amendment filed with Paper No. 12 and denial of applicants' request for withdrawal of final rejection (Paper No. 14).
March, 2003	Multiple papers filed and replied to regarding the withdrawal of the final rejection to include interview summaries, advisory actions, etc..
April 1, 2003	Notice of appeal filed with certificate of facsimile transmission. Supplemented by statement of timely filing on May 16, 2003 to comply with 37 CFR § 1.8 (see Paper No. 25).
April 17, 2003	Applicants file second Information Disclosure Statement with attorney statement that the filing has occurred before a final rejection (Paper No. 24).

Issues

Petitioners' arguments are summarized as the following:

- The examiner did not clearly develop issues for appeal in that the examiner did not set forth "a complete and cogent statement of a rejection early enough to allow a proper response." That the examiner's advisory actions are evidence that the final rejection was premature.
- The first action on the merits was incomplete which precludes making the second action final and applicant discusses the rejection of Claim 22 in particular.
- The examiner admitted to unreasonably broad claim interpretation in after final correspondence and that such "admissions" after a final rejection preclude applicants from responding.
- The examiner relied upon terms of art contrary to their meaning "to one of ordinary skill in the art" in the advisory actions.
- The examiner failed to show how the reference Richter disclosed the concept of "pages" found in Claims 51-59, 61-75, 77 and 78.
- The examiner failed to show how the reference anticipated specific method steps found in Claims 23, 28, 57, 75, 76, 78-83, 85, 95, 98-100, 102-103, 112, and 116-126.
- The obviousness rejections are incomplete.

Petitioners' are requesting relief in the form of the withdrawal of the final rejection mailed October 1, 2002, which is a petitionable matter. It is noted the original petition had a certificate of facsimile transmission dated April 10, 2003 (Paper No. 22) that is more than two months from the action complained of and therefore is untimely under 37 CFR § 1.181(f). However, the petition is not being dismissed in order to fully address petitioners' arguments.

Overview of Examiner Actions /Applicants' Amendment

In regards to the appropriateness of the examiner's final rejection: "[u]nder present practice, second or any subsequent actions on the merits **shall be final**, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)..." (Emphasis added; see MPEP § 706.07(a)). In reviewing the examiner's first action and final rejection, the record shows the examiner applied the same reference, Richter, to applicants' rejected claims in both the first action and the final rejection. While the record is silent, the final rejection indicated some of the originally rejected claims contained allowable subject matter in the final rejection; apparently due to the amended limitations added by applicants in their response filed June 26, 2002.

In the amendment filed June 26, 2002, applicants amended 44 claims and added 37 new claims. Applicants' response to the examiner's rejections omitted any discussion of the rejections of Claim 1 (independent) and focused on the pending independent claims 4, 22, 37, 51, 61, 87 and 94. Newly added claims 96, 104 and 113 were also discussed although applicants used statements such as "Claim 104 may be considered representative" without a true discussion of the limitations of Claim 113, for example. These two claims are different in scope in that Claim 104 is a method claim with specific steps that do not parallel the apparatus of Claim 113. Claim 113 also contains functional language that appears to raise questions regarding the true scope of the claimed invention. (See MPEP § 2114, "Apparatus and Article Claims – Functional Language".) Applicants did not discuss the limitations of any dependent claims, but stated "[t]hese claims also recite additional patentable features." The applicants' response did not appear to fully comply with 37 CFR § 1.111(b) in addressing every ground of objection and rejection and in presenting arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims patentable over any applied references.

Regarding Claim 22, which was changed from a dependent claim (originally depending on Claim 4) to an independent claim, applicants' stated in the June 26, 2002 filing "[t]he limitations of claim 22 appear not to be addressed in the Office Action." In the FAOM, the examiner included Claim 22 in the grouping of rejected claims in paragraph 9 but did not specifically discuss the limitations therein, which was consistent with the examiner's treatment of many of the rejected dependent claims. In reviewing applicants' amendment to Claim 22, the claim changed in scope. Applicants' stated in the June 26, 2002 amendment "claim 22 is now somewhat broader." However, at least one modification to the claim limitations removed an alternative statement and required the "indicator elements each having a value indicating the [architecture or] data storage convention under which instructions from the associated region are to be executed...". Other limitations were modified or removed which changed the scope of the claim.

Decision on Defective First Action

It is noted the June 2002 amendment included the remark, “*Applicant thanks the Examiner for his thorough consideration of a large application*” (see page 22) and omits any statements such as:

- The First Action is too sparse in its analysis of any claim to guide any reasonable applicant’s response.
- The First Action was only four pages long, with only three pages of analysis of the claims.
- No meaningful prosecution by Applicant was possible based on the extremely limited—and misleading – analysis in the First and Second Actions.
- The first Office Action is facially inadequate to constitute a good faith *prima facie* examination of the claims.

These statements are extracted from petitioners’ supplemental petition filed May 2, 2003. Also, petitioners do not appear to be complaining about the inadequacy of the examiner’s reasons for indicating allowable subject matter contained in Claims 1-21, 34-36, 37-50 or 60.

Since petitioners’ arguments relating to the adequacy of the first action on the merits were not presented within two months of the receipt of the first Office action; they are not considered timely and are not being further treated in this petition decision.

Decision on Adequacy of Examiner’s Rejections

In regards to petitioners’ other arguments, the petitioners repeatedly set forth a case as to why the examiner has not met his burden of proof of setting forth a *prima facie* (for inherency or obviousness) case for rejecting the claim limitations over the applied prior art; the examiner’s interpretation of claim limitations; the state of the art and the definitions of terms of art; and whether applicants were given a fair opportunity to respond. In regards to all but the last matter (a fair opportunity to respond), these are deemed to be appealable matters and therefore are not petitionable to the Commissioner of Patents and Trademarks.

The guidelines for petition practice are set forth in 37 CFR §1.181 “Petitions to the Commissioner.” While MPEP § 1201 outlines the differences in appealable and petitionable matters. MPEP § 1201 states in part:

The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a discretionary nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute.

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter. However, since 37 CFR 1.181(f) states that any petition not filed within 2 months from the action complained of may be dismissed as untimely and since 37 CFR 1.144 states that petitions from restriction requirements must be

filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990).

Petitioners' arguments are held to involve the merits of the case and as such are considered to involve appealable matters that will not be entertained in a petition. Applicants are advised to take the matters up on appeal.

Decision on Fair Opportunity to Respond

In regards to whether petitioners have been given a fair opportunity to respond, petitioners appear to be complaining about the extensive communications that occurred *after* the final rejection mailed October 1, 2002. The record suggests the examiner granted numerous telephone interviews with applicants giving them ample opportunity to be heard and to put the case in condition for allowance or appeal. The examiner's efforts to resolve pending matters have gone well "above and beyond" the guidelines set forth in the MPEP §713.09 regarding after final practice. Any remarks made by either party after the final rejection are not part of the official record for purposes of an appeal and the avenues of appeal or for submission of an amendment which capture the claims previously indicated to contain allowable subject matter remain open to applicants. Therefore the argument that petitioners were not provided with a fair opportunity to respond is not found to have merit.

Decision

Applicants' amendment necessitated the new grounds of rejection. The final rejection mailed October 1, 2002 is held to be proper.

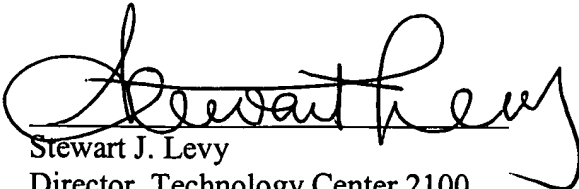
The petition is **denied**.

Application Status

The status of the application is as follows:

- The amendment filed on December 2, 2002 has not been entered for purposes of appeal.
- The information disclosure statements (IDS) filed Jan 21, 2003 and April 17, 2003 have not been considered because they were filed after the mailing of the final rejection. [Note: applicants' representative has filed statements that the IDS were being filed **before** the mailing of a final rejection. These statements are erroneous.]
- Applicants' formal drawings have not been received (see statement made by the examiner in Paper No. 11).

Questions regarding this matter should be directed to Special Program Examiner, Josie Ballato at (703) 308-0269.



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